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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,341	04/20/2001	Takahiro Hayashi	Q64162	1065

7590 07/21/2006

SUGHRUE, MION, ZINN, MCPEAK & SEAS
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Washington, DC 20037

EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 07/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/838,341	HAYASHI ET AL.	
	Examiner	Art Unit	
	Dennis Ruhl	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant's response of 5/19/06 has been entered. Currently claims 29-36 are pending. The examiner will address applicant's arguments at the end of this office action.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- DA
7/18/06
2. ^{31, 35, 36} Claims 29,30, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 29,31,35, it is not clear as to what the scope is for the limitation of "control means". Upon referencing the specification the examiner has concluded that the corresponding structure/steps that "control means" covers is not clear and is not sufficiently disclosed. This is because the examiner does not know what the structure is that is covered by the language "control means". From the specification on page 40, it is disclosed that the driver of the transportation vehicle presses a button to enable and disable the operation of the transmission means. The examiner is not clear as to whether or not the "control means" is the driver who presses the button or if the "control means" is the button itself. The button is not capable of enabling or disabling the transmission means by itself, and this leads the examiner to believe that the "control means" is the driver; however, from a structural standpoint and knowing that under 35 USC 101 a person cannot be claimed as part of the scope of an apparatus claim, the examiner also feels that one could reasonably interpret the "control means" to be the

button that is pressed by the driver. What is the disclosed structure from the specification that is covered by the language "control means"? This is not clear. From the standpoint of a prior art examination, the examiner has interpreted and assumed the language "control means" to be only the disclosed button, as the other interpretation (that the control means is the driver) renders the claim as non-statutory.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 29-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (6430496).

For claim 29,31,35, Smith discloses a transportation system where transportation vehicles 20 are dispatched to pick up either passengers or cargo. The mandatory

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terminals are located in the vehicles and are disclosed as having a transmission means, which is the communication link 22 and associated hardware/software that allows the current location information to be transmitted to the order server 10. Also see column 24, lines 47-57. See column 22, lines 5-8 where it is disclosed that to determine if a vehicle is en route, a comparison is made between two recent position readings. This is a disclosure of "periodic" transmission of location information as claimed. The means for receiving delivery information from the server can be interpreted to be the communication link 22 (that allows for the receipt of order information) or can be interpreted as the communication process 24 and associated hardware that allow the mandatory terminals to receive order information. The plurality of ordering terminals for placing an order are satisfied by the "remote data entry terminals" disclosed in column 4, lines 61-64 or are satisfied by column 4, line 65 to column 5, line 7. The means for transmitting the order information to the server is the telephone line 15 that is used to send the order information from the remote terminals to the order server 10. The order server has means for receiving the current location information of a vehicle and for specifying current location as claimed. The AVL system 18 tracks and determines the location of vehicles as claimed. Also see column 6, lines 36-41. The order server is disclosed as receiving location information from the individual vehicles so that automated dispatching can occur in an efficient manner. The means for receiving the order information is the telephone line 15 that allows the order server to receive information concerning the transportation order. The means for specifying the closest vehicle is satisfied by the fact that Smith discloses a "closest vehicle request", see

column 8, line 21 and column 13k lines 44,45. The server has means for transmitting, which is the communication process 24 and the associated hardware/software that controls the communications to the vehicles. Smith discloses that information such as start information and completion information are transmitted as claimed. See column 17, lines 30-48. Not specifically disclosed is the claimed "control means". For purposes of examination and as best understood by the examiner, from consulting the specification for guidance on what structure is covered by the "control means" language, the examiner has interpreted the "control means" to be a button that enables or disables the transmission means. This is what the examiner would interpret as an on/off button. One of ordinary skill in the art would take notice of the fact that if the mandatory terminals and their associated electronics of the transportation vehicle 20 are continuously left powered on, one would expect the batteries to run down. In view of this fact, one of ordinary skill in the art at the time the invention was made would have found it obvious to provide an on/off button, so that the navigational equipment, communication equipment and other electronics in the transportation vehicle can be turned off and on so as to not run down the vehicle battery. Applicant has disclosed a button that is pressed by the driver to either enable (on) or disable (off) the transmission means. This is the same as an on/off button that would have been obvious to one of ordinary skill in the art. The on/off button allows one to enable or disable the transmission of location information in any time period desired, which satisfies what is claimed.

For claims 30,36, nothing further is recited about the "transportation system" so the claim is satisfied by Smith. The location of the business that intends to use the recited system has nothing to do structurally with the system itself. The location of the business is not part of the transportation system so this is claiming nothing further to that recited in claim 29.

For claim 32, Smith discloses the method substantially as claimed. See the above discussion for claim 29 for what Smith discloses with respect to periodic transmission of location, receiving current location information, transmitting and receiving transportation order information, specifying the closest vehicle, etc.. Smith discloses all of the claimed steps except for the limitation that the transmission of the current location is enabled only in the claimed period (after transport and prior to another pick up). Applicant is more or less claiming the transmission of location information only when the vehicle is available for hire (either to transport an object or a person). The examiner has consulted the instant specification and does not see a problem being solved by only transmitting the current location information after delivery and prior to another pick up, and the examiner notes that there is no unexpected result obtained by this method step, so the examiner concludes the claimed limitation to be an obvious design choice that one of ordinary skill in the art would understand as being obvious. In Smith the location of a vehicle can be tracked at any time by the monitoring of periodic transmissions from the vehicle. If so desired, at any time, the order server can request the most recent location information of the vehicle. One of ordinary skill in the art would have found it obvious to monitor the vehicle only during the period the

vehicle is available for hire so that abuse and improper use of the vehicle can be identified.

For claim 33, see column 25, lines 49-63 where the use for shipping companies is disclosed. Also see column 11, lines 49-end where the management and dispatching of vehicles for multiple companies is disclosed.

For claim 34, Smith discloses the use of the system for ambulances. Ambulances frequent hospitals to pick up patients for transport to other hospitals and also drop off patients. Hospitals do not close and have "round the clock operations". This satisfies what is claimed.

6. Applicant's arguments filed 5/19/06 have been fully considered but they are not persuasive.

Applicant has argued that the transmission of location information only after a drop off and prior to another pick up is novel. The examiner disagrees and has addressed this limitation in the rejection of record. With respect to the reasoning that applicant has offered for only transmitting the location information in the claimed time period, the reasoning in the last response is confusing and does not make sense. How does the transmission of location information only when the vehicle is available do away with long waits and result in efficient and quick service? In Smith, the location information is periodically transmitted to the order server, including during the time when the vehicle is transporting an object. Why should a patent be issued to applicant for just

not transmitting location information when transporting an object or a person? The examiner does not see any novelty in the instant pending claims.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DENNIS RUHL
PRIMARY EXAMINER